UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,245	10/31/2003	Hugh Heathcote Gilbert	JYG124AUSA	2518

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EXAMINER
JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	10/699,245	GILBERT, HUGH HEATHCOTE
	Examiner	**Art Unit**	
	Jean D Janvier	3622	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _30 March 2000_.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _35-50_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _35-50_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention, under 37 CFR 1.72, should be descriptive, brief and technically accurate.

Claim Status

Claims 35-50 are now pending in the Instant Application and claims 1-34 are presently canceled.

Claim Objections

Claims 42 and 49, 43 and 50 and 44 are objected to because of the following informalities:

Concerning claims 42 and 49, "...wherein said non-subscribing advertiser is informed when said potential consumer has attempted to retrieve information concerning a product or service of said non-subscribing provider" appears to be inconsistent with the rest of the claimed invention. In fact, the claims recite providing an advertisement of a paid provider to a consumer even when the consumer is seeking information from a non-advertiser. At this point, informing the non-subscriber or non-advertiser is providing a free service to the non-advertiser and creating a competition for the paid provider or advertiser. This is totally a different concept. For examination purpose, the claim will be broadly interpreted.

Concerning claims 43 and 50, the limitations recited therein are interpreted in the alternative.

Concerning claim 44 recites "...wherein said content information provided to said potential customer includes at least one of information about a product featured in said advertisement, a music title, a hyperlink to a web site to buy a recording of a theme tune of said advertisement, a hyperlink to a web site to buy a product featured incidentally in said advertisement, a filming location of said advertisement, a hyperlink to a web site advertising a holiday at said filming location, and a hyperlink to a web site containing information about a product featured in said advertisement." The above limitations are interpreted in the alternative.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 35 (including dependent claims 36-43) and 44 (including dependent claims 45-50) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Indeed, claims 35 and 44 recite "receiving content information of advertisements from mutually unrelated providers of products and services for

advertisements placed by said mutually unrelated providers in at least one medium **other**

than the Internet....,". Here, it is unclear whether the Applicant meant to refer to the

Internet as one of the possible medium considered as the claim seems to suggest or other

media could be used as well. For examination purpose, the Examiner considers the

Internet as the medium used here as the rest of the claim seems to suggest.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-37, 40-42, 44 and 47-49 are rejected under 35 U.S.C 102(e) as being

anticipated by Davis, US Patent 6, 269, 361.

As per claims 35-37, 40-42, 44 and 47-49, Davis teaches a referral advertising

service or system for delivering product information or promotional information to a user

or customer comprising a system 10 of fig. 1 having an advertiser's web site, including

web pages 30 of fig. 1 and coupled to Advertiser Web Server 14, and an advertiser

associate's or search engine owner's web site (single web site) coupled to Search Engine

Web Server 24 of fig. 1 with a selectable link to information pertaining to the advertiser's

web site, wherein the selectable link is displayed on a search result list page associated

with the advertiser's associate's or search engine owner's web site when the user or
searcher using client 12 of fig. 1 accesses via his local browser 16 of fig. 1 a search
engine web page 36 related to the advertiser's associate's (single web site) or referring
web site and inputs a search term comprising one or more keywords corresponding to a
product or service (See abstract; col. 4: 50 to col. 6: 34; col. 10: 9-13; figs. 1 and 7).
Further, the user or customer, after the customer's or user's computer or client 12 of fig. 1
accesses the advertiser associate's or referring web site, clicks on a URL displayed on a
web page related to the referring web site to visit the advertiser's web site in order to
receive more information related to a product, such as a Zip drive, or service associated
with the inputted search query (hyperlinking to the provider's web site to retrieve more
detailed information regarding the advertisement) . It is herein recognized that the steps
of receiving and storing the advertisements (or at least the introductory portions or
teasing information related to the advertisements) from a plurality of competitors
(mutually unrelated providers) are implicitly supported in the reference.

It is further understood that when a user requests information by entering a search
term in a search field at the advertiser's associate web site, the system retrieves
information associated with a plurality of subscribing advertisers or subscribers (even if
the entered search term was specific to a non-subscriber or even if the user wanted to
direct the search to an outside advertiser) and displays the information or advertisements
in a search result list in a ranked order depending on the amount of money paid by the
advertisers (ranking products or services based on the levels of charges levied to said
subscribing providers).

(See abstract; col. 4: 50 to col. 6: 34; col. 10: 9-13; col. 9: 42 to col. 10: 13;figs. 1 and 7).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-50 are rejected under 35 USC 102(b) as being anticipated by Golhaber, US Patent 5, 794, 210

As per claims 35-42 and 44-49, Goldhaber discloses, among other things, a database 120, comprising interest profile file 124, contact information file 122 and account history file 125, directly coupled to the user's computer 104 (content delivery mechanism) and the information contained in these respective files cannot be released unless authorized by the user to advertisers or any outside third party or entity. Here, for example, the contact information file 122, storing the user's current demographic information and the interest profile file 124 storing the user's current psychographic information are coupled to the user's computer 104 and/or to the Attention brokerage server 106 or intermediary (or owner of the medium) and the intermediary cannot release the user's information or profile to any outside third party. In one embodiment, an advertiser 62 creates one or more ads 68 that appeal to certain consumers 64, not to

others, in accordance with their interest profile 124 (to targeted advertisements). The

advertiser 62 provides the targeted ads 68 to the Attention brokerage server 106 (content

provider or broadcaster or owner of the medium), acting as a broker or intermediary

between the consumers 64 and advertisers 62, which transmits or routes the one or more

created ads 68 to appropriate consumers 64 contingent upon their psychographic profile

124, stored on the Attention brokerage server 106, matching the advertiser's 62 interest

profile or criteria. In short, Attention brokerage servers 106 store information and

disseminate it to consumers' computers 104 over a network 102 and the servers 106

provide the software agent 110 with targeted or tagged ads, directed to the consumers' or

users' attention in accordance with their interest profile 124, to be viewed or reviewed by

consumers 64. Moreover, in another embodiment, a software agent 110 related to a user's

64 device or computer 104, working on behalf of the user, screens and filters the

incoming ads 68, provided to the Attention brokerage server 106 by advertiser 62,

transmitted by the Attention brokerage server 106 to be displayed to the user 64 based on

the user's psychographic information 124 stored on the user's computer 104 local

database 120. Subsequent to this screening or filtering process, matches achieving a

certain threshold of interest (adjustable by the consumer who owns the profile)

represented in the form of "agent reports" consisting of short summaries or thumbnails or

pointers are displayed on the user's computer 104, wherein, upon activating a thumbnail

view indicative of an ad matching, the user's computer 104 or the software agent 110

retrieves the full text and/or graphics corresponding to the matched advertisement 68. In

other words, the software agent 110 maintains the user's psychographic or interest profile

124 confidential and performs the screening, filtering and matching itself based on a

correlation between the ad criteria presented by the Attention brokerage server 106, on behalf of the advertiser 62, and the user's interest profile 124 stored on the user's computer 104. When matches are found, as indicated by the software agent 110, the Attention brokerage server 106 delivers the matching ads to the user's computer 104 or the software agent 110 may itself retrieve the matching ads from the Attention brokerage server 106 to be displayed on the user's computer 104. Alternatively, the software agent 110 may retrieve "thumbnail" brief summaries of the matching ads and display them along with associated Cybercoin icons on the user's computer 104, wherein upon activating a Cybercoin icon, using an input device, displayed next to a "thumbnail" brief summary representing a matching ad, the ad full text and/or graphics is retrieved and displayed to the user and the user is compensated in an amount equal to the value of the displayed Cybercoin.

Additionally, the user can also request information (initiating a search request) in real-time by providing a **user's input** and the user's personal agent 110 will submit the user's request to the network or Attention brokerage servers 106 (single web site). The user's input or new user's interest associated with this request is recorded and used to update the user's interest profile file 124 stored on the user's computer 104 or content delivery mechanism (receiving by the user's computer 104 or content delivery mechanism preference information for storage thereon, where the preference information is inaccessible to third parties-Col. 15: 1-4). In general, the user's activities or interactions or consumption are monitored or tracked and used to update or fine-tune or refine the consumer's or user's interest profile file 124 automatically (profile building scheme or mechanism). Further, the user can edit his interest profile 124 and the result of

this editing is used to update the user's interest profile file 124 (profile building scheme

or mechanism) stored on the user's computer 104 (receiving by the user's computer 104

or content delivery mechanism preference information from the user to be stored on the

user's computer 104, where the preference information is inaccessible to third parties-

Col. 17: 64 to col. 18: 12). In summary, the user's profile information (preference

information) is received by the user's computer 104 or content delivery mechanism from

the user, who uses an input device such as a mouse or keyboard to submit a request for

positive information (movie, medical reports, etc.) or negative information

(advertisements) to software agent 110, which in turn forwards the request to Attention

brokerage server 106 or content provider, wherein, for example, the "new interest"

related to the request is used to update the user's stored interest profile 124 recorded on

the user's computer 104 or content delivery mechanism and utilized in the future to filter

by the software agent 110 incoming advertisements, provided by advertisers, transmitted

from the content provider or Attention brokerage server 104.

(Col. 14: 17 to col. 15: 17; col. 15: 48 to col. 16: 5; col. 19: 26-31; col. 19: 36-61;

col. 9: 53-61; col. 6: 24-31; col. 7: 8-19; col. 8: 41-48; col. 10: 9-38).

In short, Goldhaber et al. disclose a method and/or system for brokering and

selling the attention of the customer wherein, among other things, a customer is paid to

read advertisements and wherein a software agent 110 associated with the customer's PC

104 of fig. 10 can search, over the Internet, on behalf of the customer a database storing

advertisements and display only on the customer's computer screen those advertisements

that match the customer's demographic profile and/or psychographic profile subsequent

to a filtering process that eliminates advertisements that do not fit the customer's profile

(See abstract; figs. 7 and 10; col. 12: 46 to col. 15: 6- Please notice here that interest profile as shown in fig. 7 used to filter search results also includes demographic profile). **In another embodiment, Goldhaber expressly discloses that a user can also initiate a search request or search query himself** (advertisements or search results responsive to a user search query-col. 15: 1-6). It is clearly understood that search results or information or advertisements corresponding to the user's search request will be outputted or displayed on the user's computer screen based on the user profile including demographic profile.

Finally, Goldhaber teaches a system wherein a user or consumer is paid to read targeted advertisements, from an advertiser, attention brokerage or other parties, based on the consumer's profile. In one embodiment, the consumer clicks or activates an associated Cybercoin icon 62 to initiate retrieval and display of the associated advertisement on the consumer's computer 104 screen. In the interactive embodiment, the displayed advertisement asks the consumer a series of questions related to the viewing of the advertisement. The displayed advertisement, as herein understood, having an embedded code that causes the computer 104 to send a first signal, indicative of the user's activation and the user's interaction with the said advertisement, upward to the Attention Brokerage Server 106 (administration server), which returns a message or a second signal or a digital cash, in the form of a computer code, related to the said advertisement and representative of the Cybercoin 62 to the user's computer 104 to be stored in a digital cash repository 126 subsequent to determining by the Server 106 that the user has successfully completed the process of reading the displayed advertisement (col. 16: 6-15). In another embodiment, the system or the attention brokerage server 106

allows advertisers to compete in a passive form or manner or to bid in an aggressive manner or form for the attention of a particular consumer or a group of consumers. Indeed, in the passive form, advertisers make fixed offers for viewers' attention and viewers select among the fixed offers based on a profile matching. Further, in the bidding form or "attention bidding", a mechanism by which advertisers actively or aggressively compete by bidding for a viewer's attention so as to efficiently target the viewer and to present a customized advertisement to the viewer if the viewer's profile matches the advertiser's profile is provided. The bidding might be based in part upon estimates of the viewer's interest and likelihood to buy the advertiser's product or service or on estimates derived from access to the viewer's electronic profiles detailing the viewer's preferences and past consuming behavior. The bidding may be explicit or automatic, that is the viewer may select which offer to accept or the system may offer bidding without the viewers' knowledge, wherein it is contemplated that the system is operable to select the highest bid (col. 4: 41-62). In either case, the ad or advertisement is custom-fitted to the viewer's preferences or profile, thus ensuring that the advertising messages will be welcomed and attentively viewed in an interactive manner by the viewer, wherein this ability to finely target or customize ads based on the interest or profile of a particular viewer maximizes efficiency and benefits both the advertisers and the viewers, who are encouraged to read and interact with the transmitted ads for the opportunity to receive compensations from the advertisers subsequent to positively verifying that the viewers had indeed interacted with the advertisements (col. 4: 64 to col. 5: 5; claim 47 of the present reference).

As per claims 43 and 50, while the invention has been described in connection with a computer network, wherein the content provider is the Attention brokerage server 106 and the content delivery mechanism is interpreted as the user's computer 104, it is further to be understood that the Goldhaber's system is not to be limited to a computer network. For example, although it is described above that the user or viewer uses a desktop computer or the like, however, other equipments, e.g., a television with set-top box (or a dedicated display device), could be used instead of the user's computer 104. Moreover, although the preferred instantiation of the "viewer" or user's device is connected to the other components of system 100 via the Internet 102, other forms of connection or communication network, e.g., cable TV, on-line systems, local-area networks, wide-area networks, and physically distributed CD-ROMs, are also supported. In short, the content provider can be a TV broadcaster. Finally, the Goldhaber's system as herein described is intended to cover various modifications and equivalent arrangements included within the spirit and scope of the system (; col. col. 21: 1-17).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,078,866A to Buck et al. discloses an Internet listing service for promoting advertisers' web sites.

US Patent 5,659,742A to Beattie discloses a system for storing multi-media information in an information retrieval system and for entering by a user information or a search query in a search field to conduct a search.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):
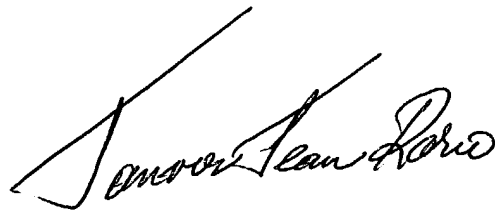
After Final-   703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

10/16/03

Jean D. Janvier

Patent Examiner

Art Unit 3622